REMARKS

In an Office Action dated August 8, 2006, the Examiner rejects 1-4, 6-29, 31-35, and 37-59 (all pending claims) and objects to the specification. In response to the Office Action, Applicants further traverse the rejections. Claims 1-4, 6-29, 31-35, and 37-59 remain in the Application. In light of the following arguments, Applicants respectfully request that the Examiner allow the pending claims and the Application.

The Examiner rejects claim 1 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 4,230,990 issued to Lert Jr. et al. (Lert). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The **test for anticipation** is symmetrical to the test for infringement and has been stated as: "That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). The Examiner has not provided a reference, Lert, that teaches each and every limitation of claim 1.

Claim 1 recites receiving an arbitrary portion of data of a work, generating a representation of said work from said arbitrary portion of data and determining an identity of said work from said representation. Lert does not teach using an arbitrary

portion of data of a work. Instead, Lert teaches using a known or specified portion of data from a work. Particularly, Lert teaches that a cue must first be received and then the data following the cue is used for feature extraction. Lert cannot work without the cues signals because then the system cannot select the proper data used to get the representation of the program. In fact, the portion of Lert specifically cited by the Examiner states this clearly in the following passage:

> Whenever a network program is broadcast by a monitored broadcasting station 20, its broadcast signal will be received by field monitor 26, which continually examines this signal for the presence of cue signals. When a cue is detected, the field monitor 26 executes the same feature extraction process to derive a broadcast signature of unknown program identity. See Col. 10, lines 13-20.

This is clear that Lert needs data from a particular portion of a work to identify a detected work specifically the data following the cue signals. Claim 1 on the other hand can use any portion of data from a work to detect the identity of the work from the use of overlapping signatures of the known works. Thus, the arbitrary portion of the works recited in claim 1 is not taught by the method of using cue signals as taught by Lert. Therefore the Applicants respectfully request that the rejection of claim 1 be removed and claim 1 be allowed.

Claims 2-4 and 6-29 are dependent upon claim 1. Thus, claims 2-4 and 6-29 are allowable for at least the same reasons as claim 1. Therefore, Applicants respectfully request that the rejections of claims 2-4 and 6-29 be removed and claims 2-4 and 6-29 be allowed.

Claim 31 recites a method performed by an analysis module including the step of generating the representation from received data as recited in claim 1. Thus, claim 31 is allowable for at least the same reason as claim 1 as it includes the step of generating the representation from the received that is not disclosed in Lert. Therefore, Applicants request the rejection of claim 31 be removed and claim 31 be allowed.

Claims 32-35 and 37-50 are dependent upon claim 31. Thus, claims 32-35 and 37-50 are allowable for at least the same reasons as claim 1. Therefore, Applicants respectfully request that the rejections of claims 32-35 and 37-50 be removed and claims 32-35 and 37-50 be allowed.

Claim 52 recites an apparatus for receiving data including data for a work, generating a representation from the data, and transmitting the representation over a network. Thus, claim 52 is allowable over Lert for at least the same reasons as claim 1. Therefore, Applicants respectfully request that the rejection of claim 52 be removed and claim 52 be allowed.

Claims 53-58 are dependent upon claim 52. Thus, claims 53-58 are allowable for at least the same reasons as claim 52. Therefore, Applicants respectfully request that the rejections of claims 53-58 be removed and claims 53-58 be allowed.

Claim 59 recites an apparatus that performs the method of claim 51. Thus, claim 59 is allowable for at least the same reasons as claim 51. Therefore, Applicants respectfully request that the rejection of claim 59 be removed and claim 59 be allowed.

The Examiner rejects claims 51 under 35 U.S.C. §103(a) as being unpatentable over Lert in view of U.S Patent Number 6,026,439 issued to Chowdhury et al.

(Chowdhury). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP § 2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. Id.

Claim 51 recites receiving a representation of data including an arbitrary portion of data of an unknown work over a network, identifying said unknown work using said representation, and updating a playlist with an identification of said representation. Lert does not teach these limitations. Instead, Lert teaches a system for identifying broadcast works, such as television programs. Lert uses the received signals to identify a broadcast by pattern matching. In order to pattern match, a received work with a known work Lert uses a trigger signal to indicate the beginning of the program. See Abstract. See also col. 6, lines 18-23. The trigger indicates a segment at a predetermined location in data of the work to compare to a comparable segment for the reference. See col. 6, lines 27-31. Thus, Lert needs a specified portion of the data of a work to identify the work. The present invention does not need a trigger signal instead the present invention generates a representation of the portion of data for the work received and can pattern match portions of the representations of portions of the known works to determine the identity of the unknown work. The Lert system only works if a specific point of the work is identified to extract the data that can be matched to stored information. Claim 51 generates a representation of all data received and then identifies the work from that representation.

Claim 51 does not need to know the beginning of the data for an unknown work like is required in Lert. Thus, Lert does not teach the generating of the representation of data claimed in claim 51 and identifying the work from the representation claimed.

Chowdhury also does not teach these limitations. Instead Chowdhury teaches a system in which the data for the work is known. Thus, Chowdhury does not teach these limitations. Since neither Lert nor Chowdhury teach the limitations of claim 51, Applicants respectfully request that the rejection of claim 51 be removed and claim 51 be allowed.

If the Examiner as any questions regarding this response or the application in general, the Examiner is invited to contact the undersigned at 775-586-9500.

Respectfully submitted,
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